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Amendments to the Drawings

Please amend the drawings by substituting the attached amended Fig. 11 for the version of Fig. 1.1 now in the application.

Fig. 11 is being amended by changing the (i.e. reversing) the labels for the output of the decision in step ST1104 to correspond to the disclosure. In this regard the Examiner's attention is directed to page 21, lines 5-12 which provides explicit support for the changes to Fig. 11. Accordingly the changes to the drawing do not introduce prohibited new matter and entry is thus respectfully requested.

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REMARKS

Upon entry of the present amendment, claims 9 and 10 will have been submitted for consideration by the Examiner. None of previously pending claims 1-8 will have been amended and no claims will have been canceled.

In view of the herein contained remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants wish to respectfully thank the Examiner for accepting the drawings filed in the present application on July 14, 2003.

By the present response, Applicants amend Fig. 11 to eliminate a minor informality.

Applicants further wish to thank the Examiner for considering the documents cited in the Information Disclosure Statement filed in the present application on October 22, 2003. In this regard, Applicants note that the cover sheet of the outstanding Official Action (PTOL-326) indicates that the PTO-1449 Form attached to the above-noted Information Disclosure Statement was attached with the outstanding Official Action. However, a PTO-1449 Form was not received by Applicants. Accordingly, Applicants respectfully request that the Examiner attach a signed and initialed copy of the PTO-1449 Form attached to the Information Disclosure Statement of October 22, 2003 to the next Official Action in the present application.

Applicants further note that a further Information Disclosure Statement was filed in the present application on December 6, 2004. This Information Disclosure Statement

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submitted a copy of a European Search Report for the Examiner's consideration together with the documents cited therein. Applicants request that the Examiner consider these documents and confirm such consideration by attaching a copy of the PTO-1449 Form attached thereto to the next Official Action in the present application.

Applicants note that the Examiner has not acknowledged Applicants Claim for Foreign Priority in the present application. In this regard, Applicants note that they have claimed foreign priority of Japanese Patent Application No. JP 9-180528 filed on June 20, 1997. A certified copy of the above-noted Japanese document was submitted in U.S. Patent Application No. 09/099,528 filed June 18, 1999 (now U.S. Patent No. 6,618,749) of which the present application claims priority under 35 U.S.C. § 120.

In the outstanding Official Action, the Examiner rejected claims 1-8 under the judicially created doctrine of double patenting over claims 1-9 of U.S. Patent No. 6,618,749. The Examiner asserted that the claimed subject matter of the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Applicants respectfully traverse the above assertion and submit that the Examiner is incorrect.

In discussing the rejection, the Examiner asserts that the editor determines whether or not the electronic message contains the TIFF header. However, Applicants note that no TIFF header is mentioned in either of the claims compared by the Examiner.

Further, Applicants note that claim 1 of the present application recites a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail was transmitted from an Internet facsimile

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apparatus. No corresponding recitation is contained in the claim of the patent. In contrast, the determiner recited in claim 1 of the '749 patent deals with determining whether or not the received e-mail data is an error message indicating that the e-mail data transmitted from the transmitter has not been successfully transmitted. The claims of the present application do not recite either a transmitter or an error message. At least for this reason, it is respectfully submitted that the Examiner's double patenting rejection is inappropriate.

Moreover, the printer of claim 1 of the present application is configured to print only image information, when the determiner determines that the document information contains the predetermined data. In direct contrast, a printer is not even recited in claim 1 of the '749 patent. Rather, the patent claim recites an editor that edits extracted specific data so as to fit on one page of recording paper having a predetermined size. No corresponding limitation is contained in the claims of the pending application. For this additional reason, it is respectfully submitted that the claims of the present application are not properly rejectable under the judicially created doctrine of double patenting over any of the claims of U.S. Patent No. 6,618,749.

Nevertheless, in order to resolve the Examiner's concerns, Applicants are filing, attached to the present paper, an executed Terminal Disclaimer with respect to U.S. Patent No. 6,618,749.

However, as noted above, there are adequate and sufficient reasons for the impropriety of the Examiner's double patenting rejection. The attached Terminal Disclaimer is being filed only as a convenience to the Examiner and so as to expedite the progress of the present application towards allowance. Moreover, the filing of this

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Terminal Disclaimer is not to be interpreted as an acquiescence, on the part of either Applicants or the Assignee of the present application, that in the absence of such filing, any double patenting rejection would be appropriate. Rather, as noted above, the Terminal Disclaimer is being filed merely in order to expedite the allowance of the claims in the present application.

In the outstanding Official Action, the Examiner rejected claims 1-8 under 35 U.S.C. § 102(e) as being anticipated by or in the alternative under 35 U.S.C. § 103 as obvious over ISHIBASHI et al. (U.S. Patent No. 6,374,291). Applicants respectfully traverse the above rejection and submit that it is inappropriate.

Applicants invention is directed to the embodiment of the invention that is illustrated, for example, with respect to the flowchart shown in Fig. 11. In this regard, Applicants claim 1 recites the combination of features making up Applicants invention. In particular, Applicants invention relates to an Internet facsimile apparatus that receives e-mail data and is connected to a computer network. The Internet facsimile apparatus includes an e-mail receiver that receives e-mail data transmitted via the computer network. The e-mail data includes a header, document information and image information. Applicants invention further includes a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus. Further, Applicants invention includes a printer that prints the entire received e-mail data when the determiner determines that the document information does not contain the predetermined data and that prints only the image information when the determiner determines that the document information contains the predetermined data. In a particular embodiment of

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the present invention, the predetermined data indicates that the e-mail is accompanied by TIFF format image data.

It is respectfully submitted that the combination of features recited in Applicants claims is not taught, disclosed nor rendered obvious by the ISHIBASHI et al. reference cited by the Examiner.

In this regard, in setting forth the rejection, the Examiner asserts that the printer recited in Applicants claim 1 is met by the printer of ISHIBASHI et al. disclosed at column 3, lines 34-39. However, the above-noted portion of ISHIBASHI et al. merely discloses that the recording part 3 is provided with a printer that records, on recording paper, image data received from another G3 or G4 facsimile device or the Internet. However, this portion of ISHIBASHI et al. clearly does not disclose that the printer prints either the entire received e-mail data or only the image information, depending on the determination of the determiner.

Regarding the determiner, the Examiner directs Applicants attention to column 6, line 60 through column 7, line 10. However, this portion of ISHIBASHI et al. also does not disclose the determiner as defined by the claims of the present application. In particular. At column 6, line 60, ISHIBASHI et al. merely discloses that since image data cannot be directly transmitted through the Internet, it must be changed into an electronic mail format by utilization of header information in a TIFF format. Further, since the TIFF image data is binary data, the TIFF image data is converted to text data and the mail editor attaches an electronic mail header to the TIFF image data converted to text data.

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However, this portion of ISHIBASHI et al. also does not disclose a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus.

Accordingly, it is respectfully submitted, for each of these reasons individually and certainly for all of these reasons, that ISHIBASHI et al. provides an inappropriate and inadequate basis for the rejection of any of the claims in the present application, whether considered under 35 U.S.C. § 102 or even if considered under 35 U.S.C. § 103. The Examiner has set forth no reason why one would provide a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus and a printer that prints in accordance with such determination of the determiner.

Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections set forth in the above-mentioned Official Action in view of the herein contained arguments.

By the present Response, Applicants have submitted several additional claims for consideration by the Examiner. These claims, as well as the previously pending dependent claims, are submitted to be patentable both based upon their own recitations as well as based upon the recitations of the respective independent claims which they inherently include.

Accordingly, Applicants respectfully request an indication of the allowability of all of claims 1-10 pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

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SUMMARY AND CONCLUSION

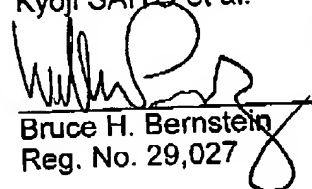
Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have not amended the claims but have submitted two additional dependent claims for consideration by the Examiner. Applicants have, while traversing the propriety of the Examiner's double patenting rejection, submitted a Terminal Disclaimer to overcome the rejection, merely to expedite allowance of the present application.

Applicants have discussed the features of Applicants invention as recited in the claims pending herein and have also discussed the disclosure of the reference relied upon by the Examiner. With respect to the disclosure of the reference, Applicants have pointed out the significant and substantial shortcomings thereof with respect to the features of Applicants invention recited in the pending claims. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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